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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1033-T00531

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on

Signature

Typed or printed name Emma L. Meyer

Application Number

10/602,010

Filed

June 23, 2003

First Named Inventor

Bruce Edward Stuckman, et al.

Art Unit

2176

Examiner

BASHORE, William L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 38,342

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Bruce Edward Stuckman et al.

Title: PATENT INFRINGEMENT NOTIFICATION SITE

App. No.: 10/602,010 Filed: June 23, 2003

Examiner: BASHORE, William L. Group Art Unit: 2176

Customer No.: 60533 Confirmation No.: 7678

Atty. Dkt. No.: 1033-T00531

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
THE PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed July 27, 2006 (hereinafter, "the Final Office Action") and further pursuant to the Notice of Appeal and Pre-Appeal Brief Request for Review submitted herewith, the Applicants respectfully request review and reconsideration of the Final Office Action in view of the following issues.

1. The Asserted Combination of Utsumi and BountyQuest Is Missing an Element of Each of the Claims.

Applicants traverse the rejection of claims 1-7, 9-22 and 24-36 under 35 U.S.C. 103(a) over European Patent No. EP 1160708 A1 ("Utsumi") in view of a web page (www.bountyquest.com) (hereinafter "BountyQuest") at page 2 paragraph 3 of the Final Office Action. The asserted combination of Utsumi and BountyQuest fails to disclose or suggest a second user input to describe how the infringement target meets the criteria, as recited by independent claims 1, 24 and 36.

Utsumi discloses a system that solicits information about products that may infringe a right-holder's patents, trademarks, or copyrights. *See Utsumi*, Abstract and col. 3, paragraph

0017. Utsumi discloses a website to receive input to identify possible infringers, including three text inputs: an email address input window, an account number input window to provide an account number to receive payment, and a detailed information input window to receive detailed information about an infringer. *See Utsumi*, Figure 3 and col. 5, paragraph 0030. The Final Office Action acknowledges:

Utsumi does not specifically teach a second user input to describe how said target meets the criteria, or of [sic] indication of an infringement target.

Final Office Action, p. 3, paragraph 3.

The Final Office Action asserts that BountyQuest teaches this feature. *See Final Office Action*, p. 3 paragraph 4. However, the BountyQuest web site is directed to identifying invalidating prior art, not potential infringers. *See BountyQuest*, p. 9. BountyQuest discloses that a “hunter” wins a bounty by being the first to submit a single document to invalidate a particular patent. *See BountyQuest*, pp. 13-14, “Does a winning submission have to invalidate the patent in question.” At page 16, BountyQuest discloses an input form to receive information related to a prior art document, including locations within a prior art submission that relate to each required element of the claims. *See BountyQuest*, p. 16. BountyQuest discloses multiple inputs, but BountyQuest fails to disclose a second user input to describe how an infringement target meets the criteria, as recited by independent claims 1, 24, and 36. BountyQuest contemplates invalidating prior art, not infringement targets. Accordingly, the asserted combination of Utsumi and BountyQuest fails to disclose or suggest at least one element of each of the independent claims 1, 24, and 36, and of claims 2-7, 9-22, and 25-35 at least by virtue of their dependency from one of the independent claims 1 and 24.

2. There Exists No Motivation to Combine the Patent Infringer Identification System of Utsumi with the Patent Invalidation System of BountyQuest.

The Final Office Action fails to establish a *prima facie* case of obviousness, because the three criteria of obviousness are not met. A *prima facie* case of obviousness requires a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. A *prima facie* case of obviousness also requires a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of

success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Finally, a prima facie case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP*, 2142.

The Final Office Action fails to establish a prima facie case of obviousness because Utsumi and BountyQuest fail to disclose or suggest a motivation to modify Utsumi to include the teachings of BountyQuest. Moreover, the systems of Utsumi and BountyQuest are in different fields of endeavor and have contradictory goals: identifying potential infringers versus identifying invalidating prior art. The Final Office Action broadly states:

The examiner fairly interprets this teaching [of BountyQuest] as directed to the user identifying an infringement target, or at the very least associated with an infringement issue (see also BountyQuest page 9, top paragraph).

Final Office Action, p. 3.

Applicants respectfully disagree. BountyQuest and Utsumi are diametrically opposed. While BountyQuest is related to “solicitation of prior art” to invalidate patents, Utsumi is directed to a system to identify potential patent infringers. The BountyQuest web page is a web site for receiving user inputs to invalidate a patent, not to “identify an infringement target” as taught by Utsumi. Accordingly, the patent infringement identifier system of Utsumi teaches away from, or is at least inconsistent with, the patent invalidation system of BountyQuest. Accordingly, there exists no motivation to modify the system to identify potential infringers of intellectual property rights of Utsumi with the system to identify invaliding prior art of BountyQuest.

Further, soliciting invalidating prior art information (as taught by BountyQuest) frustrates the purpose of the Utsumi system, namely to identify patent infringers (as taught by Utsumi). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Modifying the patent infringer identification system of Utsumi to include the invalidating prior art solicitation system of BountyQuest would render the Utsumi system unsatisfactory for its intended purpose, since

the invalidating prior art information would undermine the effort to identify infringers. Accordingly, there exists no suggestion or motivation to make the proposed modification.

Additionally, even if the combination were made, the resulting system would provide a user interface to receive patent infringement information (as taught by Utsumi) and a second user interface to receive patent invalidity information (as taught by BountyQuest). As such, the resulting combination would still fail to disclose or suggest a second user input to describe how the infringement target meets the criteria, as recited by independent claims 1, 24, and 36, and by claims 2-7, 9-22 and 25-35 which depend from one of claims 1 and 24.

Finally, it is impermissible under the framework of §103 to ignore the fact that the stated purpose of the BountyQuest web site is directly at odds with the purpose of the Utsumi system. “[I]t is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves.” *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988). “Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention. There must be a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998). Since neither Utsumi nor BountyQuest provide a motivation to make the asserted combination and since BountyQuest teaches away from Utsumi, the only motivation to make the asserted combination is provided by the present application. Thus, the asserted combination of Utsumi and BountyQuest constitutes an impermissible hindsight reconstruction based on the present application. Therefore, the rejection of claims 1-36 over Utsumi and BountyQuest is improper and should be withdrawn.

In response to the arguments presented by the Applicants at pages 7 and 8 of the Response filed on May 4, 2006, the Final Office Action asserts that since the cost of patent litigation is high, it would be obvious to solicit both potential infringer information and patent invalidity information for the same patent on the same web site, so that a patent holder can avoid

the expense of patent litigation of an issued patent that may be found invalid over a prior art reference. *See Final Office Action*, p. 8, paragraph 5.

This asserted basis for the combination ignores the diametrically opposed purposes of Utsumi (to identify infringers) and of BountyQuest (to identify invalidating prior art). Moreover, neither BountyQuest nor Utsumi provide any suggestion that the purported motivation to combine is reasonable. BountyQuest discloses that venture capital firms might use BountyQuest to assess the validity of patents owned by other companies in which they might invest. *See BountyQuest*, p. 9, top paragraph. BountyQuest makes no mention of a company wishing to identify prior art to invalidate its own patents, as suggested by the Final Office Action. Accordingly, the suggested motivation is an impermissible hindsight reconstruction based on the teachings of the present application, and the rejection of claims 1-7, 9-22 and 24-36 should be withdrawn.

CONCLUSION

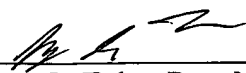
Applicants have pointed out specific features of the claims not disclosed, suggested, or rendered obvious by the references applied in the Office Action. Accordingly, Applicants respectfully request reconsideration and withdrawal of each of the rejections, as well as an indication of the allowability of each of the pending claims 1-7, 9-22 and 24-36.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

9-12-2006

Date



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